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#### REMARKS

Claims 1-9, 11-13 and 16-20 stand rejected. Claims 1-9, 11-13 and 16 are amended to explicitly recite a configurable portable electronic communication device or a portable electronic communication device. Claim 1 is further amended to recite that the receiver is configured to receive an electronic wireless transmission. Claim 8 already recites that the receiver is configured to receive an electronic wireless transmission and has been amended to specifically recite that the first and second barcode formats are scannable barcode formats. Claim 16 already recites that encrypted information is received by the portable electronic communication device over an electronic link. Support for these amendments is found in the as-filed application at least on page 4, lines 9-20. These amendments do not add new matter.

#### Rejections Under 35 U.S.C. § 102

The final Office action dated August 8, 2003 has been carefully considered and indicates that claims 1, 5, 7, 11, and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,523,794 by Mankovitz et al. (hereinafter "Mankovitz"). In response to the Examiner's rejection of claims 1, 5, 7, 11, and 16-20, independent claims 1 and 13 have been amended to recite a configurable portable electronic communication device, and independent claim 16 has been amended to recite a portable electronic communication device. Claim 1 has been further amended to recite that the configurable portable electronic communication device receives an electronic wireless transmission containing coupon information.

The Applicant respectfully submits that claim 1 defines at least the following advantageous distinctive features that distinguish over and avoid the prior art:

"a receiver configured to receive an electronic wireless transmission containing coupon information,"

"a configurable portable electronic communication device," and

"means for improving the first scan rate of the scannable coupon from the electronic display of the configurable portable electronic communication device."

All words in a claim must be considered in judging the patentability of that claim against

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the prior art when determining patentability. When the means for improving the first scan rate of a scannable coupon from the electronic display of a configurable portable electronic communication device is designed in accordance with the advantageous distinctive feature of claim 1, first scan rate is improved over conventional portable electronic communication devices.

As taught in the written description, electronic displays used with conventional portable electronic communication devices are intended to be viewed, and the attributes of such electronic displays, such as pixel size, persistence, and strobe rate, are not optimized for displaying and/or scanning barcodes from the electronic displays. Thus, the first scan rate of barcodes on such electronic displays is undesirably low. The Applicant recognized this problem and has taught various ways to improve the first scan rate. The electronic coupon disclosed in Mankovitz is a specialized article and is not a configurable portable electronic communication device as would be understood by one of ordinary skill in the art of portable electronic communication devices, particularly in light of the Applicant's disclosure (*Written Description*, page 4, lines 14-23).

Similarly, the electronic coupon of Mankovitz does not disclose or suggest a receiver configured to receive an electronic wireless transmission containing coupon information. The electronic coupon discloses an infrared receiver 16 and a serial port connector 20 for a cable for transferring information to and from the controller 12. Infrared links, which use light signals that are typically blocked by opaque objects, are not equivalent to wireless electronic links. Thus, Mankovitz teaches away from the recited receiver configured to receive an electronic wireless transmission because Mankovitz discloses a complete and operative system with two alternative techniques for transferring information from the controller 12 to the electronic coupon 10. Furthermore, modifying the electronic coupon disclosed in Mankovitz to include a receiver configured to receive an electronic wireless transmission would require a substantial redesign of both the controller 12 and the electronic coupon 10, precluding such modification. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Regarding claims 7 and 16, the Examiner states that the electronic coupon 10 must inherently provide decryption of the received decrypted data in order for the coupon devices to provide the authorization security described by Mankovitz. However, the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)(quoting *Hansgird v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)). Similarly, to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.

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*Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Mankovitz states that "data present in the VBI [video blanking interval] is further encrypted to avoid use by systems other than authorized portable coupons" (emphasis added) and that "the encoded data stripped from the VBI is retransmitted to the portable data coupon, where it is stored in memory." Col. 5, lines 34-40. The Examiner states in the Interview Summary mailed 12/29/2003 that this is taken to teach that the system stores encrypted coupon data in the portable device, and that this prevents unauthorized coupon devices from being used.

The Applicant respectfully traverses. Mankovitz states that the portable data coupon is identified and confirmed by a specific serial number of other code (Col. 5, lines 14-25), which would prevent unauthorized coupon devices from being used with the controller. The controller receives and decodes the VBI data before transferring it to the portable electronic coupon over an IR link or a serial cable. Thus it is the Applicant's position that decryption does not inherently occur in the electronic coupon 10, but is more like to occur in the controller 12.

#### Rejections under 35 U.S.C. § 103

The final Office action dated August 8, 2003 has been carefully considered and indicates that claims 2-4, 6, 8, 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,523,794 by Mankovitz et al. The Examiner states that it would have been obvious to one of ordinary skill in the art to have provided any type of well know LCD display having sufficient pixel resolution and sizing as well as well known contrast features such as anti-reflective coatings in order to provide a display of sufficient clarity so that a displayed barcode was capable of being scanned. The Examiner further states that the plurality of values for each of the various display characteristics disclosed as various operative examples suggests a lack of criticality regarding those characteristic values.

However, merely providing an LCD capable of being scanned does not suggest the present invention. The Applicant recognized the problem of low first scan rates when scanning barcodes from electronic displays. The Applicant also teaches several ways to improve the first scan rate. Contrary to the Examiner's position that the plurality of values for each of the display characteristics suggests a lack of criticality, each of the values claimed for each display characteristic evidences the Applicants creativity in solving the problem of improving the first scan rate.

The prior art did not recognize that first scan rate was a function of the claimed display

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characteristics, and therefore there was no motivation to experiment as suggested by the Examiner. Similarly, an invention is not obvious wherein well-known elements have been used to solve different problems. *Linderman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). Therefore, it is the Applicant's position that merely providing displays with various levels of visual clarity by manipulating pixel resolution and sizing as well as antireflective contrast coating does not support a conclusion of obviousness unless these elements have been used to solve the problem of a low first scan rate of barcodes displayed on a portable electronic communication device. The cited art does not recognize the problem of low first scan rate, and hence cannot suggest the means to improve the first scan rate.

Claim 2 recites particular dimensions and pixel spacing of an electronic display for improving the first scan rate and is thus further patentable.

Claims 3 and 4 recite contrast-enhancing coating for improving the first scan rate of a scannable coupon from the electronic display and are thus further patentable.

Claim 9 recites a particular strobe rate of a dot-matrix liquid crystal display as means for improving the first scan rate and is thus further patentable.

Claim 11 recites persistence sufficient to maintain sufficient contrast for electronic scanning as means for improving the first scan rate and is thus further patentable.

Regarding claim 8, the Examiner states in the final Office action that the electronic coupon disclosed in Mankovitz teaches that a single coupon's data can be represented in alphanumeric, which is easily understandable by humans, and barcode- easily understandable by machines. The Examiner further states that, at the time the invention was made, it would have been obvious to have provided the ability for the device of Mankovitz to convert the coupon data into several barcode formats so that scanning hardware requiring a particular barcode format could read the coupons and the coupons could be accepted by systems employing different barcode formats.

However, modification of Mankovitz as suggested by the Examiner is not obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). No such suggestion appears in Mankovitz. Rather, it is the Applicant who teaches the desirability of converting from one barcode format to another. *Written Description*, page 5, lines 10-21. It is impermissible to use the disclosure of the claimed invention as instructions to modify the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to deprecate the claimed invention. *Id.*, (quoting *In re Fine*, 837 F.2d 1071, 1075

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(Fed. Cir. 1988)).

In the Interview Summary mailed 12/29/2003, the Examiner states that Mankovitz teaches different coupon formats, and further states that the alphanumeric coupon can be taken to be a second barcode format. Applicant respectfully traverses. In the final Office action 08/25/2003, the Examiner stated that Mankovitz teaches that a single coupon's data can be represented in alphanumeric, which is easily understandable by humans, and barcode- easily understandable by machines. The Applicant took this to mean that displaying the coupon data in an alphanumeric format (*see* Mankovitz, Fig. 1a, ref. num. 22) was not considered to be a barcode format. On page 5, line 11 of the *Written Description*, several scannable barcode formats are disclosed. The Applicant does not believe that one of ordinary skill in the art of barcodes would consider the alphanumeric format display shown in Mankovitz to be a second barcode format. This proposition appears to arise from the Examiner's personal knowledge, and the Applicant respectfully requests an affidavit to provide an opportunity for response by the Applicant, in accordance with 37 C.F.R. § 1.104(d)(2).

#### Entry of This Amendment After Final Rejection

The Applicant recognizes that the Examiner has discretion in entering an amendment after final rejection, and believes that the present amendment is appropriate for entry. This amendment directly addresses the Examiner's concerns raised in the telephonic interview and in the final Office action relating to the means for improving the first scan rate. The Applicant has amended the preambles of independent claims 1, 8, and 13 to specifically recite a portable electronic communication device or configurable portable electronic communication device, and has included these amendments in the bodies of these claims to insure that these amendments are considered as part of the claims. This limitation underscores the distinctions over the prior art and the advantageous teachings of the Applicant. Thus, even if the Examiner is not persuaded to allow this application, this amendment places the application in better condition for appeal.

This amendment is not believed to require additional search or raise new issues. While the Applicant's amendments to the claims clarify and emphasize the novel aspects of the invention, the issues remain the same.

The Applicant believes this amendment could not have been made earlier and thus is appropriate for entry. The previous amendment is believed to have been fully responsive to the

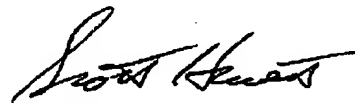
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rejection, and it is believed that the Examiner's response to the previous amendment set the stage for Applicants to respond directly to the Examiner's concerns. Entry is respectfully requested.

### CONCLUSION

The Applicant respectfully requests further examination and reconsideration of the pending claims. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by Examiner's Amendment if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner believes a telephone conference would expedite prosecution of this application, he is invited to telephone the undersigned at (707) 591-0789.

Respectfully Submitted



Scott W. Hewett  
Reg. No. 41, 836

Scott Hewett  
Patent Attorney  
400 West Third Street, No. 223  
Santa Rosa, CA 95401  
Tel.: (707) 591-0789  
Fax.: (707) 591-0392